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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,098	08/16/2000	Kenichi Haruki	000993	3148

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EXAMINER

HESELTIME, RYAN J

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/639,098	HARUKI ET AL.	
	Examiner	Art Unit	
	Ryan J Hesseltine	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) 17-27 and 31-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 13-16, 28-30 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 30, 2004 has been entered.

Election/Restrictions

2. In the reply filed December 30, 2004, there is no discussion of the withdrawal of claim 34 due to an election by original presentation. In the claim listing, claim 34 was listed as "Previously Presented" instead of "Withdrawn." However, upon further consideration, the examiner believes that the requirement for election/restriction was in error, therefore, claim 34 has been joined with the previously elected invention and is hereby examined below.

Drawings

3. The drawings were received on December 30, 2004. These drawings are acceptable.

Response to Arguments

4. Applicant's arguments on pages 11 and 12, filed December 30, 2004, have been fully considered but they are not persuasive.

5. On page 11, third paragraph, applicant states, "Matsuzaki is directed to an imaging apparatus having a box shape. This apparatus has a built-in camera unit 11, which can be taken out of the storage space and used while it is connected through a cable." The examiner would like to point out that Matsuzaki does not disclose that the camera unit 11 is being stored while it

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is within the box-like part 1b. Matsuzaki discloses that the camera unit 11 is fully functional whether disposed within or detached from the box-like unit 1b (column 5, line 40-55).

6. On page 11, last paragraph, applicant states, "Matsuzaki's imaging apparatus has nothing to do with the acquisition of identification information, and is not an apparatus to be mounted in the container portion of an image processing apparatus." The examiner respectfully disagrees. The examiner acknowledges that Matsuzaki does not explicitly disclose acquiring identification information, but it is inherently possible that identification information could be acquired with Matsuzaki's camera unit 11. Matsuzaki's Figure 2 shows that an image of an object 4, which is clearly an image of a person, may be captured and converted into an electric signal for storage in a memory circuit 17 (column 4, line 18-31). Claim 10 of the instant invention states that acquired biological information includes one of fingerprints, retinal patterns, voice, handwritings, and facial features, at least some of which can be acquired using a standard digital camera such as that disclosed by Matsuzaki. With respect to the latter part of the above statement, the examiner would first like to point out that none of the claims under consideration recite a limitation of an apparatus to be mounted in the container portion of an image processing apparatus. Matsuzaki discloses that the imaging apparatus 1 comprises a card-like part 1a, which can be inserted into a different unit or apparatus and a box-like part 1b provided at one end of the card-like part 1a (column 3, line 36-45), and further discloses that the imaging apparatus can be assembled with a portable information unit/terminal (information processing device) wherein the card-like part 1a of the imaging apparatus is inserted into a card slot 3b of the information unit/terminal 3, and is electrically connected thereto via the card connector 14 (Figure 2; column 4, line 4-17).

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7. On page 11, last paragraph, applicant states, "There is no common objective and construction between Matsuzaki's imaging apparatus and Klatt's PC-card. Further, Matsuzaki is clearly a nonanalogous art. There is no motivation to search in the field of imaging apparatus technologies and find a cable connection as taught by Matsuzaki for possible application to the identification-information-acquisition unit as taught by Klatt." The examiner respectfully disagrees. The examiner believes that there is indeed a common objective and construction between Matsuzaki's imaging apparatus and Klatt's PC-card since both disclose a card-like apparatus each including an identification-information-acquisition device (fingerprint sensor or imaging camera). Fingerprinting is well known in the art of image processing, therefore, there is definitely motivation to search in the field of imaging apparatus technologies to find a cable connection as taught by Matsuzaki, thus Matsuzaki is analogous art and there is motivation to combine the references.

8. On page 12, first paragraph, applicant states, "The cited prior art does not teach or suggest "a carrier unit which carries said identification-information-acquisition unit... said carrier unit extending to an outside of the container portion by moving out of a position where said carrier is substantially fully encased in the container portion," The examiner respectfully disagrees. Klatt explicitly discloses that a carrier unit 4 extends to an outside of the container portion by moving out of a position where said carrier is substantially fully encased (reciprocated) in the container portion (column 4, line 18-24, line 40-50).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8-10, 13-16, 28-30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klatt (DE 29821644, cited on applicant's IDS, see USPN 6,592,031 for English language equivalent) in view of Matsuzaki et al. (USPN 5,867,218, previously cited, hereafter Matsuzaki).

11. Regarding claims 8 and 28, Klatt discloses an extension device (PC card 1 according to PCMCIA standard type II) having such a configuration as to be mounted in a container portion of an information processing device (computer such as a notebook or an electronic personal organizer; column 4, line 12-17), comprising: an identification-information-acquisition (fingerprint-reading) unit (sensor 5) which receives identification (fingerprint) information (biometric data, for example, fingerprints or human retina); and a carrier unit (slide 4) which carries said identification-information-acquisition (fingerprint-reading) unit from a position where said identification-information-acquisition (fingerprint-reading) unit is encased in the container portion (reciprocated) to a position where said identification-information-acquisition (fingerprint-reading) unit is situated outside the container portion (extended) so as to permit entry of identification (fingerprint) information, said carrier extending to an outside of the container portion by moving out of a position where said carrier is substantially fully encased in the container portion (Figures 1 and 2b; column 4, line 12-23 and 40-50). Klatt discloses that said identification-information-acquisition (fingerprint-reading) unit is connectable to the information processing device through a cable (13, Figure 2b; column 4, line 42-44) but does not disclose that said identification-information-acquisition (fingerprint-reading) unit is detachable

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from said carrier unit and connectable to the information processing device through a cable when said identification-information-acquisition (fingerprint-reading) unit is detached from said carrier unit.

12. Matsuzaki discloses an imaging apparatus having box-like and card-like parts including a camera unit 11 that is detachably accommodated in the box-like part wherein the camera is connected via a cable 22 and a connector 23 (Figure 4; column 5, line 40-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the identification-information-acquisition (fingerprint-reading) unit to the information processing device when it is detached from said carrier unit as taught by Matsuzaki in order to permit hand-held imaging such as directing the camera toward an object (column 5, line 49-55) or to permit the identification-information-acquisition (fingerprint-reading) unit to be used on a desk or table top to allow the user easier access and less chance of breaking the carrier off the extension device when it is extended.

13. Regarding claim 9, Klatt discloses that said identification-information-acquisition unit includes a biological-information-acquisition unit (sensor 5) for acquiring biological (biometric) information (column 4, line 18-24).

14. Regarding claim 10, Klatt discloses that said biological information includes one of fingerprints, retinal patterns, voice, handwritings, and facial features (column 4, line 18-24).

15. Regarding claims 13 and 14, neither Klatt nor Matsuzaki explicitly disclose that said identification-information-acquisition unit includes: a left-hand-side connector, a right-hand-side connector, or a front-side connector which are to be connected to said extension device when said extension device is mounted in a left-hand side, a right-hand side, and a front-side of the

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information processing device, respectively. The examiner takes Official Notice that providing connectors on multiple sides of an information-processing device is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide left-hand, right-hand, and front connectors to be connected to an extension device in order to allow extension devices to be connected on multiple sides of the information processing device.

16. Regarding claim 15, Klatt discloses that said cable 13 has a connector (inherent) provided at a tip thereof, and said identification-information-acquisition unit further being connectable to a connector (inherent) of the extension device (PC card 1) via said cable when said identification-information-acquisition unit is attached to said carrier unit 4 (Figure 2b; column 4, line 40-44).

17. Regarding claim 16, Klatt discloses an operation unit (electrical drive 12) which prompts said carrier unit (slide 4) to engage in first motion to situate said identification-information-acquisition unit at a position that is barely sufficient for identification information to be entered in said identification-information-acquisition unit (retracted), and prompts said carrier unit to engage in second motion to expose an entirety of said identification-information-acquisition unit outside the container portion (extended; column 4, line 40-50).

18. Regarding claim 29, Klatt discloses that the extension device (PC card) is detachably mounted in the container portion (notebook computer or electronic organizer) that is configured to receive therein any one of a plurality of different types of extension devices (column 1, line 14-25).

19. Regarding claim 30, Klatt discloses that the information-processing device is a portable-type information processing device (notebook computer or electronic organizer), said container

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unit being provided with said portable-type information processing device (column 1, line 43-53).

20. Regarding claim 34, Klatt discloses a computer system comprising: an information processing device (computer such as a notebook or an electronic personal organizer); and an extension device (PC card 1 according to PCMCIA standard type II) mountable in a container portion of said information processing device (column 4, line 12-17), said extension device including: an identification-information-acquisition unit (sensor 5) which receives identification information (biometric data, for example, fingerprints or human retina); and a carrier unit (slide 4) which carries said identification-information-acquisition unit from a position where said identification-information-acquisition unit is encased in the container portion (reciprocated) to a position where said identification-information-acquisition unit is situated outside the container portion (extended) so as to permit entry of identification information (Figure 1; column 4, line 12-23 and 40-50), wherein said identification-information-acquisition unit is detachable from said carrier unit and connectable to the information processing device through a cable when said identification-information-acquisition unit is detached from said carrier unit (see above discussion of claims 8 and 28 with respect to Matsuzaki).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069.

The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan J. Hesseltine
February 3, 2005

JINGGEWU
PRIMARY EXAMINER